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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044540
Party	Plaintiff CKC HOLDINGS, INC. ,
Correspondence Address	MICHAEL M. AMIR DOLL & AMIR LLP 1888 CENTURY PARK EAST, SUITE 1106 LOS ANGELES, CA 90067
Submission	Opposition to Motion to Dismiss
Filer's Name	Michael M. Amir
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Signature	/Michael M. Amir/
Date	07/25/2005
Attachments	CKC Opposition to Motion to Dismiss.pdf (25 pages)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 2,350,558

For the Mark SIGNATURE

Date Registered: May 16, 2000

CKC Holdings, Inc.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92044540
)	
Visa International Service Association,)	
)	
Registrant)	
)	
_____)	

Commissioner for Trademarks
United States Patent and Trademark Office
Post Office Box 1451
Alexandria, Virginia 22313-1451

OPPOSITION OF PETITIONER CKC HOLDINGS, INC.

TO MOTION TO DISMISS

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Petitioner CKC Holdings, Inc. (“CKC Holdings”) acknowledges that its Petition to Cancel should have been filed as a counterclaim in Opposition Proceeding No. 91,164,506 (the “Opposition Proceeding”). Accordingly, CKC Holdings has filed a Motion to Amend its answer to add a counterclaim seeking cancellation of Registrant Visa International Service Association’s (“Visa”) mark registered under Registration No.

2,350, 558 (“Visa’s Mark”) in the Opposition Proceeding.¹ Therefore, Visa’s Motion to Dismiss is moot. Rather than dismissing CKC Holdings’ Petition to Cancel, the Board should consolidate this proceeding with the Opposition Proceeding and permit the Petition to Cancel to proceed as a counterclaim. This is precisely the action the Board took on virtually identical facts in *See’s Candy’s Shops, Inc. v. Campbell’s Soup Co.*, 12 U.S.P.Q.2d 1395 (T.T.A.B. 1989).

II. STATEMENT OF FACTS

A. Procedural Background

On July 25, 2003, CKC Holdings’ predecessor-in-interest, CKC Communications, LLC (“CKC Communications”), applied to register the mark SIGNATURE (the “Mark”) with the United States Patent and Trademark Office in International Class 36 for “[fi]nancial services, namely merchant account services, in the nature of credit and debit card services, electronic processing of payment data, and credit reporting services.” In a Notice of Publication dated August 25, 2004, the Commissioner of Trademarks stated that the Mark appeared to be entitled to registration. On September 14, 2004, the SIGNATURE Mark was published in the *Official Gazette*.²

Six months later – on March 15, 2005 – Visa initiated an opposition proceeding (Opposition No. 91164506) against CKC Communications, alleging that registration of the SIGNATURE Mark would cause it harm because the SIGNATURE Mark was likely to be confused with several of its marks, including the Visa Mark. Visa’s Mark issued

¹ For the Board’s convenience, a copy of CKC Holdings’ Motion for Leave to Amend Answer filed in the Opposition Proceeding is attached hereto as Exhibit A to the Affidavit of Michael M. Amir. A copy of CKC Holdings’ Proposed Amended Answer and Counterclaim is attached as Exhibit B to the Amir Affidavit.

² Also on July 23, 2003, CKC applied to register the Mark in International Class 35 for, among other things, “business consulting services.” That application matured in to Registration No. 2910699. Significantly, Visa never objected to the registration of the Mark for services in International Class 35.

from an application filed on September 26, 1997, in which Visa alleged a date of first use of March 20, 1998. CKC Communications filed its answer to Visa's opposition on April 22, 2005.

B. CKC Holdings Discovers that Its Date of First Use Was Earlier Than Visa's Date of First Use

Three weeks after filing its answer in the Opposition Proceeding, CKC Holdings determined that the date of first use alleged in the Application (February 1, 1999) was incorrect. Specifically, in the course of gathering evidence to prepare a defense to the Opposition Proceeding, CKC Holdings realized that it began using the SIGNATURE Mark at least as early as September 12, 1997, when CKC Communications, LLC, was formed. (Affidavit of Michael M. Amir, ¶ 4.) Given that Visa filed the application relating to the Visa Mark on September 26, 1997, and that the date of first use alleged by Visa in connection with its Mark was March 20, 1998, CKC Holdings realized that it is the senior user.

C. CKC Holdings files the Petition to Cancel

CKC Holdings does not believe that there is a likelihood of confusion between its SIGNATURE Mark and Visa's Mark. However, in order to protect its valuable trademark rights in the event that the marks were found to be confusingly similar in the Opposition Proceeding, CKC Holdings filed the Petition to Cancel on May 14, 2005 in order to establish that it is the senior user of the SIGNATURE Mark.

D. The Opposition Proceeding Is Still In Its Early Stages

The Opposition Proceeding is still in its early stages. The parties have just filed their initial pleadings. Over two months remain in the discovery period, which does not

close until October 2, 2005. Significantly, Visa – which filed the Opposition Proceeding to begin with – has not initiated any discovery. Moreover, Visa’s period for taking testimony does not close until December 31, 2005, and its period for taking testimony does not close until April 15, 2006. Accordingly, Visa will have ample opportunity to conduct discovery relating to and to prepare a defense to the proposed counterclaim.

II. LEGAL ARGUMENT

The Board should not dismiss CKC’s Petition to Cancel, but instead should consolidate this proceeding with the Opposition Proceeding and permit CKC’s Petition to Cancel to proceed as a counterclaim. This is the exact result the Board reached in *See’s Candy Shops, Inc. v. Campbell Soup Co.*, 12 U.S.P.Q.2d 1395 (T.T.A.B. 1989) in circumstances virtually identical to the instant case.

Specifically, in *See’s Candy*, Campbell Soup filed an opposition to See’s Candy’s application to register. Two weeks after it filed the answer in the opposition proceeding, See’s Candy filed a separate petition to cancel Campbell’s registration. See’s Candy knew of the grounds for cancellation at the time it filed its answer in the opposition proceeding, and thus the petition to cancel was a compulsory counterclaim in the opposition proceeding. Nonetheless, the Board held that its liberal approach toward allowing amendments to pleadings dictated that See’s Candy be permitted to assert its claim for cancellation in the opposition proceeding. *Id.* at 1397. Therefore, the Board consolidated the two proceedings and permitted See’s Candy’s request for cancellation to proceed as a counterclaim. In reaching its decision, the Board noted that “[a] liberal approach seems particularly appropriate here, where the opposition proceeding is still in

its early stages and where See's filed its petition to cancel within two weeks of the date it filed its answer to the notice of opposition." *Id.*³

See's Candy is controlling here. CKC Holdings' failure to file a counterclaim for cancellation was the result of a mere oversight. Like *See's Candy*, CKC Holdings acted promptly once it realized that it is the senior user, and thus had grounds for seeking cancellation of Visa's Mark. Indeed, the Petition to Cancel was filed only three weeks after CKC Holdings filed the answer in the Opposition Proceeding. Therefore, Visa promptly was put on notice of the allegations contained in the Petition to Cancel.

Moreover, identical to *See's Candy*, the Opposition Proceeding is in its early stages. Over two months remain in the discovery period. Moreover, Visa's period for taking testimony does not commence for several months – on December 31, 2005 – and its period for taking rebuttal testimony does not close until April 15, 2006. Visa cannot in good faith argue that it will be prejudiced by the proposed counterclaim, given that it has yet to propound any discovery in the Opposition Proceeding. Nonetheless, should Visa claim that it needs additional time to prepare a defense to the proposed counterclaim, CKC Holdings certainly will not oppose extension of any relevant deadlines in the Opposition Proceeding.

IV. CONCLUSION

Accordingly, CKC Holdings respectfully requests that the Board deny Visa's Motion to Dismiss, and instead order that this proceeding be consolidated with the

³ *See's Candy* has been followed by the Board in several unpublished decisions. *See, e.g., Mitek Corp. v. Woods Industries, Inc.*, 41 U.S.P.Q.2d 1307 (T.T.A.B. 1996) (applicant's motion for leave to add a counterclaim granted even though discovery period had closed); *Iomega Corp. v. Information Technology International Corporation*, 2001 Westlaw 826856 (T.T.A.B. 2001) ("justice requires allowing applicant to assert, by way of amendment, its omitted compulsory counterclaim for cancellation of opposer's pleaded registration.").

Opposition Proceeding and that CKC Holdings Petition to Cancel proceed as a counterclaim.

Date: July 25, 2005

Respectfully submitted,

DOLL & AMIR LLP

/Michael M. Amir/

Michael M. Amir

1888 Century Park East

Suite 1106

Los Angeles, CA 90067

Attorneys for Petitioner

CKC HOLDINGS, INC. (also known as

CKC COMMUNICATIONS, LLC)

AFFIDAVIT OF MICHAEL M. AMIR

I, Michael M. Amir, declare:

1. I am an attorney duly licensed to practice law in California and before this Board, and am a partner in the law firm of Doll & Amir LLP, counsel of record for Petitioner CKC Communications, LLC, also known as CKC Holdings, Inc. ("CKC"). All the facts stated herein are stated to the best of my knowledge.

2. Attached hereto as Exhibit A is a true and correct copy of CKC's Motion for Leave to Amend Answer filed in Opposition No. 91,164,506 (the "Opposition Proceeding") on July 25, 2005.

3. Attached hereto as Exhibit B is a true and correct copy of CKC's Proposed Amended Answer and Counterclaim submitted in the Opposition Proceeding on July 25, 2005.

4. In the course of gathering evidence to prepare CKC's defense to Visa's opposition in this proceeding, it was discovered that CKC began using the mark "SIGNATURE" at least as early as September 12, 1997, when CKC Communications, LLC was formed. This fact was discovered after CKC filed its answer in the Opposition Proceeding.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 25th day of July, 2005 at Los Angeles, California.

/Michael M. Amir/
Michael M. Amir

EXHIBIT “A”

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Visa International Service Association)	
)	
Opposer,)	
)	
v.)	Opposition No. 91,164,506
)	
CKC Communications, LLC,)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
United States Patent and Trademark Office
Post Office Box 1451
Alexandria, Virginia 22313-1451

MOTION OF APPLICANT CKC COMMUNICATIONS, LLC

FOR LEAVE TO AMEND ANSWER

Pursuant to Trademark Rule 2.107 and Federal Rule of Civil Procedure 13(f), Applicant CKC Communications, LLC, also known as CKC Holdings, Inc., (“CKC”) hereby moves this Board for an order permitting it to amend its answer in this proceeding to assert a counterclaim seeking cancellation of Opposer Visa International Service Association’s (“Visa”) mark registered under Registration No. 2,350,558 (“Visa’s Mark”) on the grounds that CKC is the senior user. A copy of the Proposed Amended Answer and Counterclaim is submitted concurrently herewith.

This Motion is based on the accompanying Memorandum of Points and Authorities and Affidavit of Michael M. Amir, the complete files and records of Cancellation Proceeding No. 92,044,540, and the complete files and records of this opposition proceeding.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

By this Motion, CKC requests that the Board permit it to amend its answer filed in this proceeding on April 22, 2005 to add a counterclaim seeking cancellation of the Visa Mark. At the time it filed its answer in this proceeding, CKC was unaware it was the senior user of the mark “SIGNATURE” (the “Signature Mark”). CKC discovered facts demonstrating that it is the senior user in the course of gathering evidence to prepare a defense in this matter. Thus, CKC’s failure to assert its seniority by a counterclaim at the time it filed its answer was due to an oversight. In light of the Board’s liberal policy permitting amendments to pleadings in opposition proceedings, and given that this proceeding is still in its early stages, the Board should grant this Motion and permit CKC to amend its answer to include the proposed counterclaim.

II. STATEMENT OF FACTS

A. Procedural Background

On July 25, 2003, CKC applied to register the SIGNATURE Mark with the United States Patent and Trademark Office in International Class 36 for “[fi]nancial services, namely merchant account services, in the nature of credit and debit card services, electronic processing of payment data, and credit reporting services.” In a Notice of Publication dated August 25, 2004, the Commissioner of Trademarks stated that the Mark appeared to be entitled to registration. On September 14, 2004, the Mark was published in the *Official Gazette*.¹

¹ Also on July 23, 2003, CKC applied to register the SIGNATURE Mark in International Class 35 for, among other things, “business consulting services.” That application matured in to Registration No. 2910699. Significantly, *Visa never objected to the registration of the SIGNATURE Mark for services in International Class 35.*

Six months later – on March 15, 2005 – Visa initiated this opposition proceeding against CKC, alleging that registration of the SIGNATURE Mark would cause it harm because the SIGNATURE Mark was likely to be confused with several of its marks, including the Visa Mark. Visa’s Mark issued from an application filed on September 26, 1997, in which Visa alleged a date of first use of March 20, 1998. CKC filed its answer to Visa’s opposition on April 22, 2005.

B. CKC Discovers that Its Date of First Use Was Earlier Than Visa’s Date of First Use

Three weeks after filing its answer, CKC determined that the date of first use alleged in its Application (February 1, 1999) was incorrect. Specifically, in the course of gathering evidence to prepare a defense to Visa’s opposition, CKC realized that it began using the SIGNATURE Mark at least as early as September 12, 1997, when CKC Communications, LLC, was formed. (Affidavit of Michael M. Amir (“Amir Aff.”), ¶ 5). Given that the date of first use alleged by Visa in connection with the Visa Mark was March 20, 1998, and that Visa’s application was filed on September 26, 1997, CKC realized that it is the senior user of the SIGNATURE Mark.

C. CKC Files a Petition to Cancel Visa’s Mark

CKC does not believe that there is a likelihood of confusion between its SIGNATURE Mark and Visa’s Mark. However, in order to protect its valuable trademark rights in the event that the marks were found to be confusingly similar in this proceeding, CKC filed the Petition to Cancel (Cancellation No. 92,044,540) on May 14, 2005 in order to establish that it is the senior user of the SIGNATURE Mark. On July 5,

2005, Visa filed a Motion to Dismiss the Petition to Cancel.² CKC has opposed the Motion to Dismiss, requesting instead that the Board consolidate this proceeding with the cancellation proceeding and permit its Petition to Cancel to proceed as a counterclaim in this proceeding. (Amir Aff., Ex. C).

D. This Proceeding Is Still In Its Early Stages

This proceeding is still in its early stages. The parties have just filed their initial pleadings. Over two months remain in the discovery period, which does not close until October 2, 2005. Significantly, Visa – which filed the opposition proceeding to begin with – has not initiated any discovery. In addition, Visa’s period for giving testimony does not close for several months – on December 31, 2005 – and its rebuttal period will not close until April 15, 2006. Accordingly, there will be ample time for Visa to seek discovery relating to and prepare a defense to the proposed counterclaim.

E. CKC Is Willing to Agree to a Short Extension of Discovery Period

Should Visa argue that it will be prejudiced by the proposed amendment because it will not have adequate time to conduct discovery relating to the counterclaim, CKC is willing to stipulate to extend the discovery period by one month in order to permit Visa to obtain relevant discovery.

II. LEGAL ARGUMENT

A. Legal Standard

Trademark Rule 2.107 provides that pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in federal court. Federal Rule of Civil Procedure 13(f) (made applicable to Board proceedings by

² For the Board’s convenience, copies of CKC’s Petition to Cancel, Visa’s Motion to Dismiss and CKC’s Opposition to Visa’s Motion to Dismiss are attached as Exhibits A through C to the Amir Affidavit.

Trademark Rule 2.116) provides that leave to amend a pleading to include a compulsory counterclaim may be granted when a pleader fails to set up a counterclaim through oversight, inadvertence, or excusable neglect, or when justice requires. *See* Wright, Miller & Kane, *6 Federal Practice and Procedure: Civil 2d, Sec. 1430*, at pp 223-24 (1990) (courts freely grant leave to add omitted counterclaims, especially where the counterclaim is compulsory).

Moreover, The Board expressly has adopted a liberal policy toward amendments and has specifically stated that “[t]he Board liberally grants leave to amend at any stage of a proceeding when justice so requires. . .” Trademark Board Manual of Procedure, Sec. 507.02. A motion to add a counterclaim generally will be denied only where allowance of the amendment would unduly prejudice the opposer. *Canon Corporation v. Helena Rubenstein, Inc.*, 193 U.S.P.Q. 113, 114 (T.T.A.B. 1976).

In *See’s Candy Shops, Inc. v. Campbell Soup Co.*, 12 U.S.P.Q.2d 1395 (T.T.A.B. 1989), the Board permitted amendment in circumstances virtually identical to the instant case. Specifically, Campbell Soup filed an opposition to See’s Candy’s application to register. Two weeks after filing an answer in the opposition proceeding, See’s Candy filed a separate petition to cancel Campbell’s registration. See’s Candy was aware of the grounds for cancellation at the time it filed its answer in the opposition proceeding. Nonetheless, the Board held that, while See’s Candy’s petition to cancel was a compulsory counterclaim in the opposition proceeding, a “liberal approach” dictated that See’s Candy be permitted to amend its answer in the opposition proceeding to assert its claim for cancellation in. *Id.* at 1397. Thus, the Board ordered that the two proceedings

be consolidated and permitted See's Candy's request to cancel Cambell's registration to proceed as a counterclaim. *Id.*³

B. The Board Should Follow *See's Candy* and Permit CKC to Amend Its Answer

Like the applicant in *See's Candy*, CKC should be permitted to amend its answer to assert its claim for cancellation for several reasons:

First, CKC's failure to seek cancellation as a counterclaim when it initially filed its answer was merely an oversight. CKC did not realize it was the senior user of the SIGNATURE Mark until after it filed its answer. Like the applicant in *See's Candy*, as soon as CKC discovered its error, it promptly asserted its claim by filing its Petition to Cancel. Indeed, the Petition to Cancel was filed only three weeks after the answer was filed.

Second, as in *See's Candy*, this proceeding is in its early stages. Over two months remain in the discovery period. Indeed, Visa has yet to propound any discovery. Moreover, Visa's period for giving testimony does not close until December 31 2005. Indeed, the Board routinely has granted leave to amend to add a counterclaim where the proceedings have progressed even further. *See, e.g., Canon*, 193 U.S.P.Q. at 114 (leave to amend granted five months after discovery had closed but before parties had taken any testimony); *Metromedia Steakhouses, Inc. v. Pondco II, Inc.*, 28 U.S.P.Q.2d 1205 (T.T.A.B. 1993)(leave to amend granted after discovery had closed).

³ *See's Candy* has been followed by the Board in several unpublished decisions. *See, e.g., Mitek Corp. v. Woods Industries, Inc.*, 41 U.S.P.Q.2d 1307 (T.T.A.B. 1996) (applicant's motion for leave to add a counterclaim granted even though discovery period had closed); *Iomega Corp. v. Information Technology International Corporation*, 2001 Westlaw 826856 (T.T.A.B. 2001) ("justice requires allowing applicant to assert, by way of amendment, its omitted compulsory counterclaim for cancellation of opposer's pleaded registration.").

Third, Visa will not be prejudiced by the amendment. As discussed above, there is ample time remaining in the discovery period for Visa to seek discovery pertaining to the proposed counterclaim. Moreover, CKC filed its Petition to Cancel only three weeks after filing its answer in this proceeding, thereby putting Visa on notice of the allegations only shortly after answering the opposition. These are precisely the circumstances on which Board in *See's Candy* based its finding that the opposer would not be prejudiced by permitting the counterclaim to proceed. *See's Candy*, 12 U.S.P.Q.2d at 1397 (“[a] liberal approach seems particularly appropriate here, where the opposition proceeding is still in its early stages and where See’s filed its petition to cancel within two weeks of the date it filed its answer to the notice of opposition.”). Finally, should Visa request additional time to adequately prepare a defense to the proposed counterclaim, CKC certainly will not oppose such a request.

Fourth, justice requires that CKC be permitted to assert its priority in this proceeding. CKC does not believe that its SIGNATURE Mark is confusingly similar to any of Visa’s marks. However, should this Board determine that the marks are confusingly similar, CKC must rely on its seniority in order to preserve its valuable trademark rights. Thus, CKC will be seriously prejudiced if this motion is denied.

Fifth, Visa has not diligently pursued the claims asserted in its Notice of Opposition. It waited over six months after the SIGNATURE Mark was published in the *Official Gazette* to file its Notice of Opposition. Moreover, since filing the Notice of Opposition, Visa has done nothing to prosecute its claim. Although the discovery period opened in April, 2005, Visa has not propounded any discovery. In these circumstances, the interests of justice plainly favor CKC.

IV. CONCLUSION

For the foregoing reasons, CKC respectfully requests that the Board grant its Motion to Amend and permit CKC to amend its answer as set forth in the Proposed Amended Answer and Counterclaim submitted concurrently herewith.

Date: July 25, 2005

Respectfully submitted,

DOLL & AMIR LLP

/Michael M. Amir/

Michael M. Amir
1888 Century Park East
Suite 1106
Los Angeles, CA 90067

AFFIDAVIT OF MICHAEL M. AMIR

I, Michael M. Amir, declare:

1. I am an attorney duly licensed to practice law in California and before this Board, and am a partner in the law firm of Doll & Amir LLP, counsel of record for Applicant CKC Communications, LLC, also known as CKC Holdings, Inc. ("CKC"). All the facts stated herein are stated to the best of my knowledge.

2. Attached hereto as Exhibit A is a true and correct copy of CKC's Petition to Cancel filed in Cancellation No. 92,044,540 (the "Cancellation Proceeding") on May 14, 2005.

3. Attached hereto as Exhibit B is a true and correct copy of Visa International Service Association's Motion to Dismiss filed in the Cancellation Proceeding on July 5, 2005.

4. Attached hereto as Exhibit C is a true and correct copy of CKC's Opposition to Motion to Dismiss filed on the Cancellation Proceeding on July 25, 2005.

5. In the course of gathering evidence to prepare CKC's defense to Visa's opposition in this proceeding, it was discovered that CKC began using the mark "SIGNATURE" at least as early as September 12, 1997, when CKC Communications, LLC was formed. This fact was discovered after CKC filed its answer in this proceeding.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 25th day of July, 2005 at Los Angeles, California.

/Michael M. Amir/
Michael M. Amir

EXHIBIT “B”

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Visa International Service Association)	
)	
Opposer,)	
)	
v.)	Opposition No. 91,164,506
)	
CKC Communications, LLC, also known)	
as CKC Holdings, Inc.)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
United States Patent and Trademark Office
Post Office Box 1451
Alexandria, Virginia 22313-1451

[PROPOSED] AMENDED ANSWER AND COUNTERCLAIM

ANSWER

Applicant CKC Communications, LLC, also known as CKC Holdings, Inc. (“CKC”), by its attorneys, hereby answers the Notice of Opposition of Opposer Visa International Service Association (“Visa”) as follows:

1. CKC admits the allegations contained in paragraph 1.
2. CKC denies that Visa will be damaged by the registration of the mark shown in Application Serial No. 78/278,841 in International Class 36 (the “Mark”). CKC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 2, and therefore denies the allegations.
3. To the extent paragraph 3 refers to the records of the U.S. Patent & Trademark Office, CKC respectfully refers the Trademark Trial and Appeal Board to the

contents thereof. CKC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 3, and therefore denies the allegations.

4. To the extent paragraph 4 refers to the records of the U.S. Patent & Trademark Office, CKC respectfully refers the Trademark Trial and Appeal Board to the contents thereof. CKC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 4, and therefore denies the allegations.

5. To the extent paragraph 5 refers to the records of the U.S. Patent & Trademark Office, CKC respectfully refers the Trademark Trial and Appeal Board to the contents thereof. CKC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 5, and therefore denies the allegations.

6. CKC is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6, and therefore denies the allegations.

7. CKC is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 7, and therefore denies the allegations.

8. CKC admits that its Mark contains the word SIGNATURE. CKC denies the remaining allegations contained in paragraph 8.

9. CKC denies the allegations contained in paragraph 9.

10. CKC admits that if its Mark is registered, it will obtain a *prima facie* exclusive right to use the Mark. CKC denies the remaining allegations contained in paragraph 10.

AFFIRMATIVE DEFENSES

1. The Notice of Opposition fails to state a claim upon which any relief can be granted.
2. There is no likelihood of confusion, mistake or deception regarding Visa's marks identified in paragraphs 3 through 5 of the Notice of Opposition because, among other things, CKC's Mark is sufficiently distinct from Visa's marks.
3. Visa's claims are barred by the equitable doctrines of laches, estoppel waiver, and acquiescence.

WHEREFORE, CKC respectfully requests that the Notice of Opposition be dismissed in its entirety with prejudice and that a registration be issued to CKC for CKC's Mark.

COUNTERCLAIM

1. CKC Holdings, Inc. (also known as CKC Communications, LLC) ("CKC"), is a California corporation located in Los Angeles California. CKC provides financial services to merchants, namely merchant account services in the nature of credit and debit card services, electronic processing of payment data, and credit reporting services.
2. Upon information and belief, Visa International Service Association is a Delaware corporation with its principal place of business at 900 Metro Center Blvd., Foster City, CA 94404.
3. At least as early as September 12, 1997, CKC adopted and began using the SIGNATURE Mark in commerce in connection with providing the financial services described in paragraph 1. CKC has continued to use that Mark in commerce since at

least September 12, 1997, and still uses that Mark. CKC has extensively advertised and promoted the SIGNATURE Mark in connection with its financial services.

4. CKC has expended considerable effort to promote its financial services business using the SIGNATURE Mark. CKC has provided services in connection with the SIGNATURE Mark throughout the United States. As a result of CKC's success, the SIGNATURE Mark has become well-known in the financial services industry among merchants in the United States. CKC has made extensive use of the SIGNATURE Mark, and the Mark has become associated with CKC in the minds of merchants purchasing financial services such as those provided by CKC.

5. As a result of the extensive use of the SIGNATURE Mark by CKC, CKC has developed and now possesses significant trademark rights in and to the SIGNATURE Mark. These rights constitute a valuable business asset of CKC.

6. On July 25, 2003, CKC applied to register the SIGNATURE Mark with the United States Patent and Trademark Office in International Class 36 for “[f]inancial services, namely merchant account services, in the nature of credit and debit card services, electronic processing of payment data, and credit reporting services.” In a Notice of Publication dated August 25, 2004, the Commissioner of Trademarks stated that the Mark appeared to be entitled to registration. On September 14, 2004, the Mark was published in the *Official Gazette*.

7. The mark registered under Registration No. 2,350,558 ("Visa's Mark") comprises the words VISA SIGNATURE. Visa's Mark issued from an application filed on September 26, 1997. The identification of goods recited in Visa's Mark states “[b]anking services, namely credit card, debit card, charge card, electronic

payment card, prepaid card, point-of-sale card, cash advance card and stored-value-card services; deposit access services; electronic funds transfer services; automatic teller machine services” in International Class 36. In its application, Visa identified the date of first use of the mark as March 20, 1998.

8. On March 14, 2005, Visa filed a Notice of Opposition opposing registration of Petitioner’s Mark. In the Opposition, Visa claims that if CKC’s Mark is registered, “confusion in trade resulting in damage and injury to Visa International would be caused and would result by reason of the similarity between CKC’s SIGNATURE and Design mark and Visa International’s marks.” CKC does not believe that its Mark and that of Visa are confusingly similar. However, if a likelihood of confusion does exist between the two marks, then CKC will be damaged by such confusion.

9. CKC has been using the SIGNATURE Mark since well prior to the date of first use of Visa’s Mark and also since well prior to September 26, 1997, the date on which Visa filed the application that matured into Registration No. 2,350,558. As a result, as between CKC’s Mark and Visa’s Mark, CKC’s Mark has priority, and thus is entitled to be registered in the United States Patent and Trademark Office.

10. CKC does not believe that there is a likelihood of confusion between CKC’s Mark and Visa’s Mark. However, if CKC’s Mark and Visa’s Mark are confusingly similar, CKC is being damaged by the continued registration of the mark shown in Registration No. 2,350,558. Therefore, Registration No. 2,350,558 should be canceled under Section 2(d) of the Lanham Act.

WHEREFORE, CKC prays that Registration No. 2,350,558 be cancelled.

Date: July 25, 2005

Respectfully submitted,

DOLL & AMIR LLP

/Michael M. Amir/

Michael M. Amir

1888 Century Park East

Suite 1106

Los Angeles, CA 90067

CERTIFICATE OF SERVICE

I hereby certify that on July 25, 2005, a true and correct copy of the
OPPOSITION OF PETITIONER CKC HOLDINGS, INC. TO MOTION TO DISMISS
was served by first class mail, postage prepaid, upon:

Garner K. Weng, Esq.
Hanson Bridgett Marcus Vlahos & Rudy LLP
333 Market Street, 21st Floor
San Francisco, CA 94105
Attorney for Visa International Service Association

Dated: July 25, 2005

/Michael M. Amir/
Michael M. Amir

Counsel for CKC Communications,
LLC, also known as CKC Holdings,
Inc.